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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/518,356	12/17/2004	Tokutomi Watanabe	47233-0048	8100
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STULIL, VERA				
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08/13/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/518,356

Applicant(s)

WATANABE ET AL.

Examiner

VERA STULII

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Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 May 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13 and 15-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13 and 15-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 13, 15-16, 18-30 and 32-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Liu (CN 1237624) in view of Tarkmishvili et al for the same reasons as stated in the Non-Final Office action mailed 01/27/2009 (pp. 4-7) .

In regard to claims 13, 23 and 27, Liu is silent as to the soluble solid content of the tea leaf extract. However, Liu discloses extraction of tea leaves with solvents in the ratio of 1:15 of tea leaves to water (page 2 of the translation claim 2), which is in the range as disclosed by the applicant (see 3rd paragraph on page 5 of the specification). Therefore, the amount of soluble solids extracted from the tea leaves would be expected to be in the range as claimed absent any clear and convincing arguments and/or evidence to the contrary.

In regard to the newly amended claims 21 and 34 that now recite the low alcohol drink having alcohol content of 12% or less, Liu discloses the following amounts of beverage components (page 1 bottom paragraph, page 2 top paragraph):

- 100 kg of tea juice extract (1:15 ratio of tea leaves to water);
- 800-1000 L of water;
- 50-120 L of grape wine;
- 10-90 L of distilled spirit;
- 100-200 L of fruit juice;

- 50-100 kg granulated sugar;
- 0.1-0.2 g/kg of sodium benzoate;
- 0.5-1 g/kg of vitamin C;
- foaming agent;
- 0.1-0.2 g/kg polyphosphate;
- colorant

Based on the calculation of the percentage of the alcohol content of the tea beverage composition using the data as stated above (assuming distilled spirit having 40% of alcohol content and grape wine having 12% alcohol content), the alcohol content of the tea beverage composition is approximately from 0.01% to 0.03%, which is in the range as claimed.

Claim 17 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Liu (CN 1237624) in view of Tarkmishvili et al as applied to claims 16 and 26 above, and further in view of Gong Yungao (CN 1285153) for the same reasons as stated in the Non-Final Office action mailed 01/27/2009 (pp. 7-8).

Response to Arguments

The rejection of claims 13 and 15-35 under 35 U.S.C. 112, first paragraph has been withdrawn due the amendments of claims 13, 23 and 27.

Applicant's arguments filed 05/07/2009 have been fully considered but they are not persuasive.

On page 7 of the Reply to the Office action mailed 01/27/2009, Applicants state that "[t]he alleged obviousness rejection is improper for at least the following reasons:

- 1) the Office uses impermissible hindsight to combine Liu and Tarkmishvili;
- 2) Liu teaches away from the proposed modification;
- 3) the Office impermissibly relied on inherency in an obviousness rejection; and
- 4) no reason is provided for why optimization of the amount of soluble solid content of tea extract in Liu leads to an amount within the claimed range".

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning (page s7-8 of the Remarks), it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). Liu discloses foam forming beverage containing tea leaf extract. Tarkmishvili et al disclose a novel foaming agent from tea extract which could replace egg white in the production of zefir (foamy confectionery product) and replace it entirely in the production of soufflé. Tarkmishvili et al disclose that the extract is made from "current types of tea leaves". Egg whites were well known in the art to be used in the foamy confectioneries for foam formation and foam holding properties. Therefore, as disclosed by Tarkmishvili, tea extract possesses similar foam formation and foam

holding properties to whipped egg whites. Therefore, one of ordinary skill in the art would have been motivated to use tea extract as a foam forming and foam holding agent.

In response to the teaching away argument, it is noted that Liu discloses a foam forming beverage comprising tea leaf extract, and that the amount of soluble solids of the tea extract appears to be in the range as claimed. As stated in the Office action above, Liu discloses extraction of tea leaves with solvents in the ratio of 1:15 of tea leaves to water (page 2 of the translation claim 2), which is in the range as disclosed by the applicant (see 3rd paragraph on page 5 of the specification). Therefore, the amount of soluble solids extracted from the tea leaves would be expected to be in the range as claimed absent any clear and convincing arguments and/or evidence to the contrary.

On page 8 of the Reply, applicants state that "[o]ne of ordinary skill in the art, without the knowledge of the claimed invention, would not have created a foam producing drink as claimed for at least the following reasons:

- a) Liu fails to recognize that tea extract is a foam holding agent, and
- b) Tarkmishvili only discloses that tea extract can be a substitute for egg whites as the foaming agent in forming air-filled foam not CO₂-filled foam".

In response to this argument, it is noted that Liu is not relied upon as a teaching of a tea extract as a foam holding agent. Liu is relied upon as a teaching of a foam forming beverage comprising tea leaf extract. Therefore it is not clear how Liu could be teaching away by disclosing foam forming beverage containing tea leaf extract as claimed (see also pages 9-10 of the Response). In response to applicant's argument

that Liu fails to recognize that tea extract is a foam holding agent, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985). Further in this regard, it is noted that Tarkmishvili is relied upon as a teaching of a tea extract as a foam holding agent. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Further in response to the argument regarding air-filled foam vs. CO₂-filled foam (pages 8-9 of the Reply), it is noted that air comprises carbon dioxide, and soft beverages or low-alcoholic beverages form contains air as well, therefore it is not clear how this argument is relevant.

On page 8 of the Reply, applicants state that "sodas require little foam formation" and that "[a]t least one of the objects of Applicants' foam producing drink is to form a drink with strong foam holding properties that resemble the head on beer". In response to this argument, Applicants attention is referred to the recitation of "soda pop, a lemon soda drink, a carbonated fruit drink or a low alcohol drink having an alcohol content of 12% or less" in claims 21 and 34. Further in this regard it is noted that Liu et al meets the limitations of claims 21 and 34. See Office action as stated above.

In response to Applicants' arguments regarding the inherency of the foam holding properties (pages 9-11 of the Reply), it is noted that claim 13 recites "[a] foam

producing drink comprising carbon dioxide, a foaming agent and a tea leaf extract wherein the tea leaf extract containing a soluble solid content is obtained by water, water/ethanol or ethanol extraction, and is a foam-holding component, wherein the soluble solid content of the tea leaf extract is included in the drink in an amount of 0.01% to 3% by weight relative to the total volume of the drink, wherein said drink has a foam-holding property". As stated in the Office action above, Liu discloses a foam producing (forming) drink comprising carbon dioxide, a foaming agent and a tea leaf extract wherein the tea leaf extract containing a soluble solid content is obtained by water, water/ethanol or ethanol extraction, wherein the soluble solid content of the tea leaf extract is included in the drink in an amount of 0.01% to 3% by weight relative to the total volume of the drink, wherein said drink. Tarkmishvili is relied upon as a teaching of a tea extract as a foam holding agent. Therefore, Applicants' arguments are not deemed persuasive.

In response to Applicants' arguments that "Gong Yungao fails to cure the deficiencies of Liu" (page 12 of the Reply), it is noted that Gong Yungao is relied upon as a teaching of a tea beverage "with medical health care" action containing hops and tea leaf extract. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to VERA STULII whose telephone number is (571)272-3221. The examiner can normally be reached on 7:00 am-3:30 pm, Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Keith Hendricks can be reached on (571) 272-1401. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

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you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Lien Tran/
Primary Examiner
Art Unit 1794

/Vera Stulii/
Examiner, Art Unit 1794